

## REMARKS

This Response is submitted in reply to the Office Action dated September 7, 2007. Applicant elect have elected Group I, Claims 1 to 20. Claims 21 to 96 are withdrawn. Claim 1 has been amended. The specification has been amended. No new matter has been added by these amendments.

A Petition for a One Month Extension of Time to respond to the Office Action is submitted herewith. A Supplemental Information Disclosure Statement is submitted herewith. Please charge deposit account 02-1818 for any fees which are due in connection with this Petition for a One Month Extension of Time, this Supplemental Information Disclosure Statement and this Response.

The Office Action rejected Claims 1 to 4, 12 to 14, 19, and 20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,018,293 to Brown et al. ("Brown") in view of U.S. Patent No. 5,833,238 to Watanabe ("Watanabe").

Brown discloses a bonus game including a representation of an Othello type game with a six-by-six grid of squares. The game includes game chips or pieces used in the bonus game, wherein each chip is black on one side and white on the other side. In an example shown in Fig. 8, the player selects a color game piece (for example, the black side). The bonus game begins with four pieces 128, 130, 132, and 134 in the center of the six-by-six board with the player's selected color displayed. Surrounding these four pieces are twelve pieces with the opponent's color which is the color not selected by the player (in this example, the white side). The operation of the bonus game is based on the basic legal move in the Othello type board game, which is placing pieces with the player's color next to any opponent's colored pieces, such that an "outflanking" of the opponent's colored pieces may occur. Outflanking occurs when a game piece with the player's color is placed in an empty square such that one or more of the opponent's pieces are in consecutive squares (in a line) between the new position of the player's piece and another piece of the player's color. This may occur on a horizontal, vertical or diagonal line. After the piece is played, all of the outflanked pieces of the opponent's color are flipped or turned over so that they now show the player's color. According to this game's methodology, a piece cannot be legally placed in an open square that does not outflank opponent's piece.

Brown also discloses that the gaming device uses a random number generator to randomly select one of the twenty open squares on the board. The gaming device can select a legal or illegal open square. Once a square is selected, a new piece with the player's color is placed in the square and any opponent (white in this example) pieces outflanked by the new player piece and another player piece are turned to the player's color (black in this example). After the opponent pieces are flipped, the gaming device determines the number of the player's pieces (black in this example) on the board and highlights the corresponding value in a paytable. The value is displayed to the player in a bonus win meter. The random selection of squares continues until an illegal open square is selected or the 12 pieces are placed on the game board for the player.

Brown further discloses a distribution of possible games for the Othello type game in Tables 3 and 4. This distribution is weighted by the probability of each event. For example, looking at the occurrence count of a game ending with six player pieces, Table 3 shows that it can happen sixteen different ways, all of which occur on the second "spin" of the bonus round.

Watanabe discloses a game played on a board marked with a square array of horizontal and vertical rows of elemental squares. First and second players initially hold a set of first pieces such as black round pieces and a set of second pieces such as red round pieces, respectively. Each player alternately places a piece at an unoccupied square, trying to occupy all the locations of one horizontal or vertical row, to use up all the piece of the hand, and to capture more opponent's pieces. Each side can place a new piece if the new piece is horizontally or vertically adjacent to a comrade piece on the board. If the new piece is horizontally or vertically adjacent to an enemy piece on the board, the new piece and the adjacent enemy piece are replaced. Pieces are captured if they are completely enclosed and there are no adjacent unoccupied locations.

Amended independent Claim 1 is directed to a method of operating a gaming device that includes displaying a playing board having a plurality of positions, enabling each of a plurality of chips to be placed individually at one of the positions, the chips being either game chips or player chips, wherein placement of one of the game chips that causes at least one player chip to be flanked on opposite sides by game chips

converts each the flanked player chip to a game chip, and wherein placement of one of the player chips that causes at least one game chip to be flanked on opposite sides by player chips converts each the flanked game chip to a player chip. The method of operating a gaming device also includes using a table in memory to place at least one game chip at one of the positions, wherein the table is weighted according to a desired total number of player chips remaining after a player places each of a provided amount of player chips onto the positions, and awarding the player based on the remaining number of player chips after the player placed the provided amount of player chips onto the positions.

As discussed during the telephone interview, Applicant respectfully submits that neither Brown nor Watanabe individually nor the method of operating a gaming device resulting from the combination of Brown and Watanabe disclose using a table in memory to place at least one game chip at one of the positions, wherein the table is weighted according to a desired total number of player chips remaining after a player places each of a provided amount of player chips onto the positions. The Office Action relied on Table 3 of Brown to disclose a table that is weighted according to a desired total number of player chips remaining after a player places each of a provided amount of player chips onto the positions. Office Action page 7. However, Table 3 in Brown only appears to disclose a distribution of possible games (e.g., the number of different ways that the game can be completed). While Brown mentions that "this distribution must be weighted by the probability of each event." (Brown Column 27, lines 54 to 56), Brown is referring to the actual probability of ending a game with a particular number of game pieces. That is, the probability of ending the game with a smaller number of pieces (such as 6 pieces) is greater than ending the game with a large number of pieces (such as 28 pieces). Thus, Table 3 in Brown represents the natural weighted distribution for game play rather than a weighted distribution to achieve a particular outcome. Furthermore, Brown discloses that the gaming device uses a random number generator to select locations on the game board to place the player chips and does not disclose using a weighted table. Watanabe also does not disclose using a weighted table to select a location on a game board. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Brown and Watanabe to result in such a

method of operating a gaming device without reasonably being construed as improper hindsight reconstruction. On the other hand, the method of operating a gaming device of amended independent Claim 1 includes using a table in memory to place at least one game chip at one of the positions, wherein the table is weighted according to a desired total number of player chips remaining after a player places each of a provided amount of player chips onto the positions. Accordingly, for this reason, Applicant respectfully submits that amended independent Claim 1 is patentably distinguished over Brown in view of Watanabe and in condition for allowance.

Claims 2 to 4, 12 to 14, 19, and 20 depend directly or indirectly from amended independent Claim 1 and are also allowable for the reasons given with respect to amended independent Claim 1 and because of the additional features recited in these claims.

The Office Action rejected Claims 5 to 11 under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Watanabe and further in view of U.S. Patent No. 6,439,995 to Hughs-Baird et al. ("Hughes-Baird").

Hughs-Baird discloses an apparatus and method that includes a gaming device having a bonus round with multiple selection groups. The bonus round does not end upon an end-bonus indicator; rather, the bonus round ends when the player chooses a predetermined number of selections from the last or final selection group. The last or final selection group includes an award indicator associated with each selection. In one embodiment of Hughs-Baird, the number of player choices or picks in the final selection group is determined from a selection group preceding the final selection group. However, the number of picks could be determined in any suitable manner.

Page 11 of the Office Action stated that "it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Brown, Watanabe and Hughs-Baird in order to provide a bonus game wherein awarding the player is based on a combination of values associated with positions having player chips as the inventions are analogous gaming devices in the same field of endeavor." Regardless of whether it would have been obvious to include a bonus game wherein awarding the player is based on a combination of values associated with positions having player chips, neither Brown in view of Watanabe nor Hughs-Baird nor the

method of operating a gaming device resulting from the combination of Brown in view of Watanabe and Hughs-Baird, disclose using a table in memory to place at least one game chip at one of the positions, wherein the table is weighted according to a desired total number of player chips remaining after a player places each of a provided amount of player chips onto the positions. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Brown in view of Watanabe and Hughs-Baird to result in such a method of operating a gaming device without reasonably being construed as improper hindsight reconstruction. On the other hand, Claims 5 to 11 each includes using a table in memory to place at least one game chip at one of the positions, wherein the table is weighted according to a desired total number of player chips remaining after a player places each of a provided amount of player chips onto the positions. Accordingly, for this reason and the reasons provided with respect to amended independent Claim 1, Applicant respectfully submits that Claims 5 to 11 are patentably distinguished over Brown in view of Watanabe and further in view of Hughs-Baird and are in condition for allowance.

The Office Action rejected Claims 15 to 18 under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Watanabe and further in view of U.S. Published Patent Application No. 2002/0090988 to Frost et al. ("Frost").

Frost discloses a gaming table in which the outcome of the game is determined manually, and in which players place bets electronically and wins or losses are calculated electronically. The gaming system is applicable to any suitable game including roulette.

Page 12 of the Office Action stated that "it would have been obvious to combine the teachings of Brown, Watanabe, and Frost in order to provide a game wherein awarding the player is based on a combination of values associated with chips as the inventions are analogous gaming devices in the same field of endeavor." Regardless of whether it would have been obvious to include a game wherein awarding the player is based on a combination of values associated with chips, neither Brown in view of Watanabe nor Frost nor the method of operating a gaming device resulting from the combination of Brown in view of Watanabe and Frost, disclose using a table in memory to place at least one game chip at one of the positions, wherein the table is weighted

according to a desired total number of player chips remaining after a player places each of a provided amount of player chips onto the positions. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Brown in view of Watanabe and Frost to result in such a method of operating a gaming device without reasonably being construed as improper hindsight reconstruction. On the other hand, Claims 15 to 18 each includes using a table in memory to place at least one game chip at one of the positions, wherein the table is weighted according to a desired total number of player chips remaining after a player places each of a provided amount of player chips onto the positions. Accordingly, for this reason and the reasons provided with respect to amended independent Claim 1, Applicant respectfully submits that Claims 15 to 18 are patentably distinguished over Brown in view of Watanabe and further in view of Frost and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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